

BRYAN CAVE LLP

Marcy J. Bergman, California Bar No. 75826
Katherine Keating, California Bar No. 217908
Robert J. Esposito, California Bar No. 267031
560 Mission Street, Suite 2500
San Francisco, CA 94105
Telephone: 415-675-3400
Facsimile: 415-675-3434
E-mail: marcy.bergman@bryancave.com
katherine.keating@bryancave.com
robert.esposito@bryancave.com

Attorneys for Plaintiff
COST PLUS MANAGEMENT SERVICES, INC.

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

COST PLUS MANAGEMENT SERVICES,
INC.,

Plaintiff,

vs.

FRESCO WORLD MARKET EASTRIDGE
LLC a/k/a FRESCO WORLD MARKET LLC
d/b/a FRESCO WORLD MARKET,

Defendant.

Case No. 3:12-cv-05545-EDL

**CONSENT JUDGMENT AND
PERMANENT INJUNCTION**

Action Filed: October 29, 2012

BRYAN CAVE LLP
560 MISSION STREET, SUITE 2500
SAN FRANCISCO, CA 94105

1 The parties hereto having agreed to a settlement of the claims between them, and having
 2 stipulated to entry of this consent judgment, it is hereby ORDERED, ADJUDGED AND
 3 DECREED:

4 1. This Court has jurisdiction over defendant Fresco World Market Eastridge LLC
 5 a/k/a Fresco World Market LLC d/b/a Fresco World Market ("Fresco World Market") and over
 6 the subject matter at issue in this action. Defendant Fresco World Market consents to jurisdiction
 7 of this Court for the purpose of executing and enforcing this Consent Judgment and Permanent
 8 Injunction, and this Court retains jurisdiction for this purpose.

9 2. Plaintiff Cost Plus Management Services, Inc. ("Cost Plus") is the owner of the
 10 mark WORLD MARKET in connection with retail store services and a wide range of goods,
 11 including food and beverage items, and owns numerous U.S. trademark registrations for the
 12 WORLD MARKET mark, including registrations covering retail store services (Reg. No.
 13 2,418,723), various food and beverage items (Reg. Nos. 2,347,302; 2,422,735; 2,438,006;
 14 2,556,914; and 3,412,612), various household goods, furniture, and decorative items (Reg. Nos.
 15 2,415,201; 2,415,202; 2,422,738; 2,422,739; 2,422,740; 2,477,108; 2,556,540; 2,559,368;
 16 2,582,756; 2,613,029; 2,675,831), and café services (Reg. No. 2,840,285).

17 3. Cost Plus also owns federal registrations for the mark COST PLUS WORLD
 18 MARKET in connection with retail stores services featuring general merchandise (Reg. No.
 19 1,772,080), WORLD MARKET PAIRINGS in connection with chocolate (Reg. No. 3,794,065),
 20 and WORLD MARKET EXPLORER in connection with customer loyalty programs (Reg. No.
 21 3,787,412).

22 4. The trademarks referenced in Paragraphs 2-3 above are collectively referred to
 23 herein as the "WORLD MARKET Trademarks."

24 5. Cost Plus has the exclusive right to use the WORLD MARKET Trademarks in
 25 commerce on or in connection with retail store services, food, beverages, household goods,
 26 furniture, decorative items, café services, customer loyalty programs, and related goods and
 27 services.
 28

BRYAN CAVE LLP
 560 MISSION STREET, SUITE 2500
 SAN FRANCISCO, CA 94105

BRYAN CAVE LLP
560 MISSION STREET, SUITE 2500
SAN FRANCISCO, CA 94105

6. Fresco World Market acknowledges the validity of the WORLD MARKET Trademarks and the ownership rights of Cost Plus therein.

7. Fresco World Market has used the mark FRESCO WORLD MARKET in connection with a retail store located in San Jose, California, and with food and beverage items sold in that store, as depicted in Exhibit A hereto.

8. Fresco World Market obtained a U.S. trademark registration for the FRESCO WORLD MARKET composite word and design mark in connection with “retail and on-line grocery store services featuring home delivery service; retail grocery stores; [and] supermarkets” (Reg. No. 4,184,033). A copy of the registration certificate for this mark is attached hereto as Exhibit B.

9. Within five (5) business days of the date of execution of this Consent Judgment, Fresco World Market shall pay the sum of \$10,000 to Cost Plus.

10. Within five (5) business days of the date of execution of this Consent Judgment, Fresco World Market shall surrender Registration No. 4,184,033 to the United States Patent and Trademark Office (“USPTO”) for cancellation.

11. Within thirty (30) days of the date of execution of this Consent Judgment, Fresco World Market will cause traffic to the domain name frescoworld.com to be redirected to a domain name that does not contain the term “world.”

12. Within sixty (60) days of the date of execution of this Consent Judgment, Fresco World Market will take all actions necessary to transfer the domain name frescoworld.com to Cost Plus.

13. Within sixty (60) days of the date of execution of this Consent Judgment, Fresco World Market will cease all use of the mark FRESCO WORLD MARKET in commerce, including on store signage, in advertising, and on products and will instead use the mark FRESCO MARKET, FRESCO INTERNATIONAL MARKET, or FRESCO SUPERMARKET.

14. As of sixty (60) days from the date of execution of this Consent Judgment, Fresco World Market, and each of its officers, directors, agents, servants, employees, subsidiaries, affiliates, predecessors, successors, and/or other related companies, and persons in active concert

BRYAN CAVE LLP
560 MISSION STREET, SUITE 2500
SAN FRANCISCO, CA 94105

or participation with Fresco World Market who receive actual notice of this judgment by personal service or otherwise, are permanently enjoined from doing any of the following:

a. manufacturing, importing, exporting, distributing, licensing, selling, marketing, advertising, promoting, or offering for sale any goods or services under (i) the mark FRESCO WORLD MARKET; (ii) any other name or mark that includes the term “world”; or (iii) any other name or mark confusingly similar to the WORLD MARKET Trademarks;

b. using “world market” or any terms confusingly similar thereto in connection with any business name, company name, or domain name;

c. making any false representation or performing any act likely to induce the mistaken belief that Cost Plus has in any way approved or is affiliated with, connected to, or associated with Fresco World Market or its products or services;

d. registering or seeking to register with any agency, including but not limited to the USPTO, any name or mark that includes the term “world” or that is confusingly similar to the WORLD MARKET Trademarks;

e. challenging or assisting others in challenging, either directly or indirectly, the validity, ownership, or enforceability of the WORLD MARKET Trademarks in any U.S. court (state or federal) or other tribunal of the world, including but not limited to the USPTO.

15. Within sixty (60) days of the date of execution of this Consent Judgment, Fresco World Market will remove all interior signage that includes the mark FRESCO WORLD MARKET and will destroy or deliver to counsel for Cost Plus all labels, packaging boxes, catalogs, advertisements, point of sale materials and other marketing materials in the possession or control of Fresco World Market bearing the mark FRESCO WORLD MARKET. Fresco World Market shall provide written confirmation of the destruction of the materials set forth above within two (2) days of such destruction, specifying the materials that have been destroyed.

16. Notwithstanding the provisions above, Fresco World Market shall have ninety (90) days from the date of execution of this Consent Judgment to remove all exterior signage that includes the mark FRESCO WORLD MARKET.

17. Any violation of this Consent Judgment by Fresco World Market shall cause Cost Plus irreparable harm, entitling Cost Plus to an immediate injunction against Fresco World Market to cease all actions constituting said violation.

18. The parties enter into this Consent Judgment freely and without coercion and acknowledge that they understand all of the provisions of this Consent Judgment and are prepared to abide by them.

19. This Consent Judgment shall inure to the benefit of Cost Plus and its successors and assigns.

IT IS SO ORDERED.

Dated: _____, 2012

By: _____
The Honorable Elizabeth D. Laporte
United States District Court

We hereby consent to entry of this Consent Judgment and Permanent Injunction:

Dated: December 5, 2012

RAJ ABHYANKER P.C. dba LEGALFORCE RAPC
WORLDWIDE

By: /s/ Kuscha Hatami
Kuscha Hatami
Attorneys for Defendant
FRESCO WORLD MARKET EASTRIDGE
LLC a/k/a FRESCO WORLD MARKET LLC
d/b/a FRESCO WORLD MARKET

Dated: December 6, 2012

BRYAN CAVE LLP

By: /s/ Marcy Bergman
Marcy Bergman
Attorneys for Plaintiff
COST PLUS MANAGEMENT SERVICES,
INC.

I, Marcy Bergman, attest that concurrence in the filing of this document has been obtained from the other signatory. I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on December 6, 2012, at San Francisco, California.

/s/ Marcy Bergman
Marcy Bergman

BRYAN CAVE LLP
560 MISSION STREET, SUITE 2500
SAN FRANCISCO, CA 94105

17. Any violation of this Consent Judgment by Fresco World Market shall cause Cost Plus irreparable harm, entitling Cost Plus to an immediate injunction against Fresco World Market to cease all actions constituting said violation.

18. The parties enter into this Consent Judgment freely and without coercion and acknowledge that they understand all of the provisions of this Consent Judgment and are prepared to abide by them.

19. This Consent Judgment shall inure to the benefit of Cost Plus and its successors and assigns.

IT IS SO ORDERED.

Dated: December 11, 2012

By: Elijah D. Laporte
The Honorable Elizabeth D. Laporte
United States District Court

We hereby consent to entry of this Consent Judgment and Permanent Injunction:

Dated: 12/15, 2012

Raj Abhyankar P.C.
dba LEGALFORCE RAPC WORLDWIDE

By: Kuscha Hatami
Attorneys for Defendant
FRESCO WORLD MARKET EASTRIDGE
LLC a/k/a FRESCO WORLD MARKET LLC
d/b/a FRESCO WORLD MARKET

Dated: _____, 2012

BRYAN CAVE LLP

By: _____
Marcy Bergman
Attorneys for Plaintiff
COST PLUS MANAGEMENT SERVICES,
INC.

BRYAN CAVE LLP
560 MISSION STREET, SUITE 2500
SAN FRANCISCO, CA 94105

EXHIBIT A



EXHIBIT B

United States of America

United States Patent and Trademark Office



Reg. No. 4,184,033

Registered July 31, 2012

Int. Cl.: 35

SERVICE MARK

PRINCIPAL REGISTER

FRESCO WORLD MARKET LLC (CALIFORNIA LIMITED LIABILITY COMPANY), DBA
FRESCO WORLD MARKET,
1838 N MILPITAS BLVD
MILPITAS, CA 95035

FOR: RETAIL AND ON-LINE GROCERY STORE SERVICES FEATURING HOME DELIVERY
SERVICE; RETAIL GROCERY STORES; SUPERMARKETS, IN CLASS 35 (U.S. CLS. 100,
101 AND 102).

FIRST USE 7-1-2011; IN COMMERCE 12-18-2011.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MARKET" AND "FRESCO",
APART FROM THE MARK AS SHOWN.

THE COLOR(S) RED, ORANGE, LIGHT GREEN, AND DARK GREEN IS/ARE CLAIMED AS
A FEATURE OF THE MARK.

THE MARK CONSISTS OF TWO HALF-MOON SHAPES. AN ORANGE HALF-MOON ON
THE LEFT AND RED HALF-MOON ON THE RIGHT WITH TWO LEAVES ABOVE. A LIGHT
GREEN LEAF ON THE LEFT AND DARK GREEN LEAF ON THE RIGHT. THE WORDING
"FRESCO" IS RED AND THE WORDING "WORLD MARKET" IS GREEN.

SN 85-259,152, FILED 3-6-2011.

SHAUNIA CARLYLE, EXAMINING ATTORNEY



David J. Kyfos

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*
What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*
What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or reminder of these filing requirements.

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.